

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 20-25, 30, 32-36, 39, 42-43, 48-54, 80, 86, 92-93, 95, 98-106, and 111 have been amended and claims 19, 46-47, 91, and 109-110 have been canceled. No new matter has been added. Claims 2-18, 26-29, 45, and 56-79 were previously canceled. Thus, claims 1, 20-25, 30-44, 48-55, and 80-90, 92-108, and 111-112 are currently pending in the application and subject to examination.

I. Allowable Subject Matter

The Applicants thank the Examiner for the indication of allowable subject matter in claims 19-25 and 47. Claim 19 has been rewritten in independent form, as suggested by the Examiner, by including its features in independent claim 1. Claim 47 has been rewritten in independent form, as suggested by the Examiner, by including its features in independent claim 30.

II. Claim Objections

In the Office Action mailed March 5, 2007, claims 1, 19-25, 30, 32-36, 39, 42, 43, 48-54, 91-93, 95, 98-102, and 109 are objected to for informalities. These claims have been amended responsive to the objections. Therefore, the Applicants request the withdrawal of the objections to claims 1, 19-25, 30, 32-36, 39, 42, 43, 48-54, 92-93, 95, and 98-102.

III. 35 U.S.C. § 101

Claims 92-95 and 98-100 are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Claims 92-95 and 98-100 have been amended to include an electronic book viewer and to clarify that the electronic book is stored in a computer readable medium. Therefore, the Applicants submit that the claimed invention is not directed to software *per se* but to a system including electronic books stored in a computer readable medium. The system further includes an electronic book viewer, which is a hardware component.

The Office Action also asserted that the claims did not include a concrete and tangible result “such as displaying an electronic book on a computer monitor or transmitting an electronic book via a computer network.” These claims have been amended to recite that when the first component is selected, the second component is displayed on the electronic book viewer. Therefore, the Applicants submit that the claims recite a tangible, concrete result to form.

IV. 35 U.S.C. § 112, first paragraph

Claims 1, 19-25, 80-85, 91, and 102-108 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

Claims 1, 80, and 103 have been amended responsive to this rejection. Therefore, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 112.

V. 35 U.S.C. § 112, second paragraph

Claims 30, 33-44, and 51-55 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. These claims have been amended or canceled

responsive to this rejection. If any further amendments are necessary to overcome this rejection, the Examiner is requested to contact the undersigned representative.

VI. Art Rejections

Claims 1, 30-34, 39, 40, 43, 44, 46, 48-50, 80-82, 85-91, 103, and 104 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,557,722 to DeRose et al. ("DeRose"). Under 35 U.S.C. § 103(a), claims 35, 36, 51, 52, 83, and 84 are rejected as being unpatentable over DeRose in view of U.S. Patent No. 5,241,671 to Reed et al. ("Reed"); claims 37 and 38 as being unpatentable over DeRose in view of Reed and further in view of U.S. Patent No. 5,761,485 to Muyan ("Muyan"); claims 41, 42, 93, 94, 99, 106, and 107 claims 39-42, as being unpatentable over DeRose in view of U.S. Patent No. 6,052,717 to Reynolds et al. ("Reynolds"); claims 53-55, 92, 102, and 105 as being unpatentable over DeRose in view of Muyan; claims 98 and 108 as being unpatentable over DeRose in view of U.S. Patent No. 6,460,036 to Herz ("Herz"); and claims 95-97, 100, 101, and 109-112 as being unpatentable over DeRose in view of Reynolds, and further in view of Muyan. It is noted that claims 1, 20-25, 30, 32-36, 39, 42-43, 48-54, 80, 86, 92-93, 95, 98-106, and 111 have been amended and claims 19, 46-47, 91, and 109-110 have been canceled. To the extent that the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections as follows.

A. Claims 1, 20-25, 30-44, 48-55, 80-90, and 102

Claim 19 is indicated as containing allowable subject matter. Claim 19 has been rewritten in independent form by incorporating their subject matter in independent claims 1 and 80. Claim 47 is indicated as containing allowable subject matter. Claim

147 has been rewritten in independent form by incorporating their subject matter in independent claims 30 and 86. For at least this reason, the Applicants submit that claims 1, 30, 80, and 86 are allowable over the cited art. As claims 1 and 30 are allowable, the Applicants submit that claims 20-25, 31-44, 48-55, 81-85, 87-90, and 102, which depend from allowable claims 1, 30, 80, and 86, are therefore also allowable.

B. Claims 92-101, 103-108, and 11-112

Applicants' invention as now set forth in claim 92 is directed to an electronic book system including an electronic book viewer; an electronic book, the electronic book stored in a computer readable medium in the electronic book viewer; and links among components of the electronic book; wherein when the links are activated, a first component is linked to a second component; wherein the first component is located in the electronic book; and wherein the second component is located in a data repository at a distant operations center; and wherein selection of the first component causes the second component to be displayed on the electronic book viewer.

By linking components of the electronic book stored in a viewer to second components stored in a data repository at a distant operations center allows any number of previously distributed electronic books to contain links to information that is continuously updated at the one distant operations center. Thus, an operations center can offer books containing enhanced features that are continuously current regardless of when the electronic books were received and stored in the viewer.

The Office Action admits that DeRose does not disclose or suggest a link connecting a first component located in the electronic book that connects to a second component located at a distant operations center.

The Office Action cites Munyan as teaching an electronic file at a location where electronic books can be ordered and purchased.

Although Munyan teaches a system for ordering and transmitting electronic books, Munyan does not disclose or suggest remotely storing links to components of electronic books stored in a viewer such that the links are stored at a distant operations center, as recited in claim 92. None of the cited art teaches at least this claimed combination.

Regarding claim 93, the Office Action cites Reynolds as teaching electronic books and additional content, all of which are part of the Internet. However, the Applicants submit that Reynolds does not disclose or suggest a system including at least the combination of an electronic book stored in an electronic book viewer and links among components of the electronic book, wherein a first component is located in the electronic book and a second component is located at a distant data repository accessible by a server on a network, as recited in amended claim 93. In contrast, Reynolds teaches both the book and the additional content stored on the Internet.

Herz fails to cure the deficiency in DeRose, Munyan, and Reynolds.

For at least this reason, the Applicants submit that claims 92 and 93 are allowable over the cited art. For similar reasons, the Applicants submit that claims 95, 98, 99, 103, and 111 are likewise allowable. As claims 92, 93, 95, 98, 99, 103, and 111 are allowable, the Applicants submit that claims 94, 96-97, 100-101, 104-108, and 112,

which depend from allowable claims 92, 93, 95, 98, 99, 103, and 111 are also allowable for at least the above noted reason and for the additional subject matter recited therein.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper reason to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a reason to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 20-33. This is an insufficient showing of obviousness.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references.

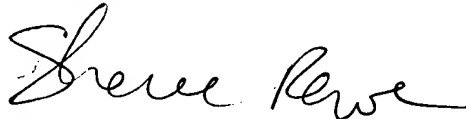
Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 026880-00008.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read "Sheree Rowe", written in a cursive style.

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